

29 JUN 2000  
09/582719Practitioner's Docket No. 101195-2

## CHAPTER II

## Preliminary Classification:

Proposed Class:

Subclass:

NOTE: "All applicants are requested to include a preliminary classification on newly filed patent applications. The preliminary classification, preferably class and subclass designations, should be identified in the upper right-hand corner of the letter of transmittal accompanying the application papers, for example 'Proposed Class 2, subclass 129.'" M.P.E.P., § 601, 7th ed.

# TRANSMITTAL LETTER TO THE UNITED STATES ELECTED OFFICE (EO/US)

## (ENTRY INTO U.S. NATIONAL PHASE UNDER CHAPTER II)

PCT/DE98/03818 December 30, 1998 December 30, 1997  
INTERNATIONAL APPLICATION NO. INTERNATIONAL FILING DATE PRIORITY DATE CLAIMED

Novel Sequence Variants of the Human Beta 2- Adrenergic Gene  
TITLE OF INVENTION

Hoehe, Margaret; Timmermann, Bernd; Koepke, Karla  
APPLICANT(S)

## Box PCT

Assistant Commissioner for Patents  
Washington D.C. 20231

ATTENTION: EO/US

## CERTIFICATION UNDER 37 C.F.R. § 1.10\*

(Express Mail label number is mandatory.)  
(Express Mail certification is optional.)

I hereby certify that this Transmittal Letter and the papers indicated as being transmitted therewith is being deposited with the United States Postal Service on this date June 29, 2000, in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number EL643059849UA, addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

Barbara LaRocca

(type or print name of person mailing paper)

Barbara LaRocca

Signature of person mailing paper

**WARNING:** Certificate of mailing (first class) or facsimile transmission procedures of 37 C.F.R. § 1.8 cannot be used to obtain a date of mailing or transmission for this correspondence.

**\*WARNING:** Each paper or fee filed by "Express Mail" **must** have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. § 1.10(b).

"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will **not** be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

**NOTE:** To avoid abandonment of the application, the applicant shall furnish to the USPTO, not later than 20 months from the priority date: (1) a copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the USPTO; and (2) the basic national fee (see 37 C.F.R. § 1.492(a)). The 30-month time limit may not be extended. 37 C.F.R. § 1.495.

**WARNING:** Where the items are those which can be submitted to complete the entry of the international application into the national phase are subsequent to 30 months from the priority date the application is still considered to be in the international state and if mailing procedures are utilized to obtain a date the express mail procedure of 37 C.F.R. § 1.10 must be used (since international application papers are not covered by an ordinary certificate of mailing—See 37 C.F.R. § 1.8.

**NOTE:** Documents and fees must be clearly identified as a submission to enter the national state under 35 U.S.C. § 371 otherwise the submission will be considered as being made under 35 U.S.C. § 111. 37 C.F.R. § 1.494(f).

I. Applicant herewith submits to the United States Elected Office (EO/US) the following items under 35 U.S.C. § 371:

- a. ☒ This express request to immediately begin national examination procedures (35 U.S.C. § 371(f)).
- b. ☒ The U.S. National Fee (35 U.S.C. § 371(c)(1)) and other fees (37 C.F.R. § 1.492) as indicated below:

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## 2. Fees

CLAIMS FEE	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
<input type="checkbox"/>	TOTAL CLAIMS	33 - 20 =	13	× \$18.00 =	\$ 234.00
	INDEPENDENT CLAIMS	3 - 3 =	0	× \$78.00 =	
	MULTIPLE DEPENDENT CLAIM(S) (if applicable) + \$260.00				
BASIC FEE**	<input type="checkbox"/> U.S. PTO WAS INTERNATIONAL PRELIMINARY EXAMINATION AUTHORITY Where an International preliminary examination fee as set forth in § 1.482 has been paid on the international application to the U.S. PTO: <input type="checkbox"/> and the international preliminary examination report states that the criteria of novelty, inventive step (non-obviousness) and industrial activity, as defined in PCT Article 33(1) to (4) have been satisfied for all the claims presented in the application entering the national stage (37 C.F.R. § 1.492(a)(4)) ..... \$96.00 <input type="checkbox"/> and the above requirements are not met (37 C.F.R. § 1.492(a)(1)) ..... \$670.00 <input checked="" type="checkbox"/> U.S. PTO WAS NOT INTERNATIONAL PRELIMINARY EXAMINATION AUTHORITY Where no international preliminary examination fee as set forth in § 1.482 has been paid to the U.S. PTO, and payment of an international search fee as set forth in § 1.445(a)(2) to the U.S. PTO: <input type="checkbox"/> has been paid (37 C.F.R. § 1.492(a)(2)) ..... \$690.00 <input type="checkbox"/> has not been paid (37 C.F.R. § 1.492(a)(3)) ..... \$970.00 <input checked="" type="checkbox"/> where a search report on the international application has been prepared by the European Patent Office or the Japanese Patent Office (37 C.F.R. § 1.492(a)(5)) ..... \$840.00				\$ 840.00
	Total of above Calculations =				\$ 1074.00
SMALL ENTITY	Reduction by 1/2 for filing by small entity, if applicable. Affidavit must be filed also. (note 37 C.F.R. § 1.9, 1.27, 1.28)				- 537.00
	Subtotal				
	Total National Fee				\$ 537.00
	Fee for recording the enclosed assignment document \$40.00 (37 C.F.R. § 1.21(h)). (See Item 13 below). See attached "ASSIGNMENT COVER SHEET".				
TOTAL	Total Fees enclosed				\$ 537.00

\*See attached Preliminary Amendment Reducing the Number of Claims.

- i. ☐ A check in the amount of \_\_\_\_\_ to cover the above fees is enclosed.
- ii. ☒ Please charge Account No. 14-1263 in the amount of \$ 537.00  
A duplicate copy of this sheet is enclosed.

**\*\*WARNING:** "To avoid abandonment of the application the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 30 months from the priority date: \* \* \* (2) the basic national fee (see § 1.492(a)). The 30-month time limit may not be extended." 37 C.F.R. § 1.495(b).

**WARNING:** If the translation of the international application and/or the oath or declaration have not been submitted by the applicant within thirty (30) months from the priority date, such requirements may be met within a time period set by the Office. 37 C.F.R. § 1.495(b)(2). The payment of the surcharge set forth in § 1.492(e) is required as a condition for accepting the oath or declaration later than thirty (30) months after the priority date. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than thirty (30) months after the priority date. Failure to comply with these requirements will result in abandonment of the application. The provisions of § 1.136 apply to the period which is set. Notice of Jan. 3, 1993, 1147 O.G. 29 to 40.

3. ☒ A copy of the International application as filed (35 U.S.C. § 371(c)(2)):

NOTE: Section 1.495 (b) was amended to require that the basic national fee and a copy of the international application must be filed with the Office by 30 months from the priority date to avoid abandonment. "The International Bureau normally provides the copy of the international application to the Office in accordance with PCT Article 20. At the same time, the International Bureau notifies applicant of the communication to the Office. In accordance with PCT Rule 47.1, that notice shall be accepted by all designated offices as conclusive evidence that the communication has duly taken place. Thus, if the applicant desires to enter the national stage, the applicant normally need only check to be sure the notice from the International Bureau has been received and then pay the basic national fee by 30 months from the priority date." Notice of Jan. 7, 1993, 1147 O.G. 29 to 40, at 35-36. See item 14c below.

- a. ☒ is transmitted herewith.
- b. ☐ is not required, as the application was filed with the United States Receiving Office.
- c. ☒ has been transmitted
- i. ☐ by the International Bureau.  
Date of mailing of the application (from form PCT/1B/308): \_\_\_\_\_
- ii. ☐ by applicant on \_\_\_\_\_  
Date

4. ☒ A translation of the International application into the English language (35 U.S.C. § 371(c)(2)):

- a. ☐ is transmitted herewith.
- b. ☐ is not required as the application was filed in English.
- c. ☐ was previously transmitted by applicant on \_\_\_\_\_  
Date
- d. ☒ will follow.

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5. ☐ Amendments to the claims of the International application under PCT Article 19 (35 U.S.C. § 371(c)(3)):

*NOTE: The Notice of January 7, 1993 points out that 37 C.F.R. § 1.495(a) was amended to clarify the existing and continuing practice that PCT Article 19 amendments must be submitted by 30 months from the priority date and this deadline may not be extended. The Notice further advises that: "The failure to do so will not result in loss of the subject matter of the PCT Article 19 amendments. Applicant may submit that subject matter in a preliminary amendment filed under section 1.121. In many cases, filing an amendment under section 1.121 is preferable since grammatical or idiomatic errors may be corrected." 1147 O.G. 29-40, at 36.*

- a. ☐ are transmitted herewith.
- b. ☐ have been transmitted
  - i. ☐ by the International Bureau.  
Date of mailing of the amendment (from form PCT/1B/308): \_\_\_\_\_
  - ii. ☐ by applicant on (date) \_\_\_\_\_  
Date
- c. ☒ have not been transmitted as
  - i. ☒ applicant chose not to make amendments under PCT Article 19.  
Date of mailing of Search Report (from form PCT/ISA/210.): \_\_\_\_\_
  - ii. ☐ the time limit for the submission of amendments has not yet expired.  
The amendments or a statement that amendments have not been made will be transmitted before the expiration of the time limit under PCT Rule 46.1.

6. ☐ A translation of the amendments to the claims under PCT Article 19 (38 U.S.C. § 371(c)(3)):
- a. ☐ is transmitted herewith.
  - b. ☐ is not required as the amendments were made in the English language.
  - c. ☐ has not been transmitted for reasons indicated at point 5(c) above.
7. ☐ A copy of the international examination report (PCT/IPEA/409)
- ☐ is transmitted herewith.
  - ☐ is not required as the application was filed with the United States Receiving Office.
8. ☐ Annex(es) to the international preliminary examination report
- a. ☐ is/are transmitted herewith.
  - b. ☐ is/are not required as the application was filed with the United States Receiving Office.
9. ☐ A translation of the annexes to the international preliminary examination report
- a. ☐ is transmitted herewith.
  - b. ☐ is not required as the annexes are in the English language.

10. ☒ An oath or declaration of the inventor (35 U.S.C. § 315 (4)) complying with 35 U.S.C. § 115

- a. ☐ was previously submitted by applicant on \_\_\_\_\_  
Date
- b. ☐ is submitted herewith, and such oath or declaration
- i. ☐ is attached to the application.
- ii. ☐ identifies the application and any amendments under PCT Article 19 that were transmitted as stated in points 3(b) or 3(c) and 5(b); and states that they were reviewed by the inventor as required by 37 C.F.R. § 1.70.
- c. ☒ will follow.

II. Other document(s) or information included:

11. ☒ An International Search Report (PCT/ISA/210) or Declaration under PCT Article 17(2)(a):

- a. ☐ is transmitted herewith.
- b. ☒ has been transmitted by the International Bureau.  
Date of mailing (from form PCT/IB/308): \_\_\_\_\_
- c. ☐ is not required, as the application was searched by the United States International Searching Authority.
- d. ☐ will be transmitted promptly upon request.
- e. ☐ has been submitted by applicant on \_\_\_\_\_  
Date

12. ☐ An Information Disclosure Statement under 37 C.F.R. §§ 1.97 and 1.98:

- a. ☐ is transmitted herewith.  
Also transmitted herewith is/are:
- ☐ Form PTO-1449 (PTO/SB/08A and 08B).
- ☐ Copies of citations listed.
- b. ☐ will be transmitted within THREE MONTHS of the date of submission of requirements under 35 U.S.C. § 371(c).
- c. ☐ was previously submitted by applicant on \_\_\_\_\_  
Date

13. ☐ An assignment document is transmitted herewith for recording.

A separate ☐ "COVER SHEET FOR ASSIGNMENT (DOCUMENT) ACCOMPANYING NEW PATENT APPLICATION" or ☐ FORM PTO 1595 is also attached.

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14. ☒ Additional documents:

- a. ☐ Copy of request (PCT/RO/101)
- b. ☒ International Publication No. W099/37761
- i. ☒ Specification, claims and drawing
- ii. ☐ Front page only
- c. ☒ Preliminary amendment (37 C.F.R. § 1.121)
- d. ☒ Other

small entity declaration

\_\_\_\_\_

\_\_\_\_\_

15. ☒ The above checked items are being transmitted

- a. ☒ before 30 months from any claimed priority date.
- b. ☐ after 30 months.

16. ☐ Certain requirements under 35 U.S.C. § 371 were previously submitted by the applicant on \_\_\_\_\_, namely:

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

**AUTHORIZATION TO CHARGE ADDITIONAL FEES**

**WARNING:** Accurately count claims, especially multiple dependant claims, to avoid unexpected high charges if extra claims are authorized.

**NOTE:** "A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission." 37 C.F.R. § 1.136(a)(3).

**NOTE:** "Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account." 37 C.F.R. § 1.26(a).

☒ The Commissioner is hereby authorized to charge the following additional fees that may be required by this paper and during the entire pendency of this application to Account No. 14-1262

☒ 37 C.F.R. § 1.492(a)(1), (2), (3), and (4) (filing fees)

**WARNING:** Because failure to pay the national fee within 30 months without extension (37 C.F.R. § 1.495(b)(2)) results in abandonment of the application, it would be best to always check the above box.

☐ 37 C.F.R. § 1.492(b), (c) and (d) (presentation of extra claims)

NOTE: Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 C.F.R. § 1.492(d)), it might be best not to authorize the PTO to charge additional claim fees, except possible when dealing with amendments after final action.

☐ 37 C.F.R. § 1.17 (application processing fees)

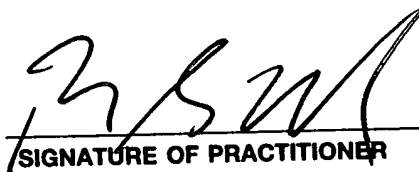
☐ 37 C.F.R. § 1.17(a)(1)-(5) (extension fees pursuant to § 1.136(a).

☐ 37 C.F.R. § 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 C.F.R. § 1.311(b))

NOTE: Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance. 37 C.F.R. § 1.311(b).

NOTE: 37 C.F.R. § 1.28(b) requires "Notification of any change in loss of entitlement to small entity status must be filed in the application . . . prior to paying, or at the time of paying . . . issue fee." From the wording of 37 C.F.R. § 1.28(b): (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.

☐ 37 C.F.R. § 1.492(e) and (f) (surcharge fees for filing the declaration and/or filing an English translation of an International Application later than 30 months after the priority date).

  
SIGNATURE OF PRACTITIONER

Reg. No.: 33,531

Tel. No.: (212) 968 1300

Customer No.:

Bruce S. Londa  
(type or print name of practitioner)

Norris, McLaughlin & Marcus, P.A.  
P.O. Address

20 Exchange Place, 37th fl.  
New York, New York 10005

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*Attn. Mr. Lorida!*

Applicant or Patentee:  
Serial or Patent Number:  
Filed or Issued:  
For:

Hoehe et al.  
PCT/DE98/03818

Attorney's Docket No

Novel Sequence Variants of the Human Beta2-Adrenergic Gene

Verified Statement (Declaration) Claiming SMALL ENTITY  
Status (37 CFR 1.9(f) and 1.27 (d)) - Small Business Concern

I hereby declare that I am

- ☐ the owner of the small business concern identified below  
☒ an official of the small business concern empowered to act on behalf of the concern identified below

NAME OF CONCERN Max-Delbrück-Centrum für Molekulare Medizin  
ADDRESS OF CONCERN Robert-Rössle-Strasse 10, Berlin D-13125, Germany

I hereby declare that the above identified small business concern qualifies as a small business concern as defined in 13 CFR 121.3-18, and reproduced in 37 CFR 1.9(d), for purposes of paying reduced fees under section 41(a) and (b) of Title 35, United States Code, in that the number of employees of the concern, including those of its affiliates, does not exceed 500 persons. For purposes of this statement, (1) the number of employees of the business concern is the average over the previous fiscal year of the concern of the persons employed on a full-time, part-time or temporary basis during each of the pay periods of the fiscal year, and (2) concerns are affiliates of each other when either, directly or indirectly, one concern controls or has the power to control the other, or a third party or parties controls or has the power to control both.

I hereby declare that rights under contract or law have been conveyed to and remain with the small business concern identified above with regard to the invention, entitled

Novel Sequence Variants of the Human Beta2-Adrenergic Gene

by inventor(s) Hoehe et al

described in PCT/DE98/03818, filed 30 December 1998

If the rights held by the above identified small business concern are not exclusive, each individual, concern or organization having rights to the invention is listed below\* and no rights to the invention are held by any person, other than the inventor, who could not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e).

NAME:

ADDRESS:

☐ Individual

☐ Small Business Concern

☐ Nonprofit Organization

NAME:

ADDRESS:

☐ Individual ☐ Small Business Concern ☐ Nonprofit Organization

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b))

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

NAME OF PERSON SIGNING: \_\_\_\_\_

TITLE OF PERSON OTHER THAN OWNER: \_\_\_\_\_

ADDRESS OF PERSON SIGNING: \_\_\_\_\_

SIGNATURE

*F. Baumgart*

DATE

*29.06.00**by order!*